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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,202	02/01/2001	Johnny B. Corvin	UV-181	7104

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EXAMINER	
BELIVEAU, SCOTT E	

ART UNIT	PAPER NUMBER
2614	

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/775,202	CORVIN ET AL.	
	Examiner	Art Unit	
	Scott Beliveau	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 February 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,6-18,35,36 and 40-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,6-18,35,36 and 40-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 February 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed continues to fail to provide adequate support under 35 U.S.C. 112 for claims 1, 2, 6-18, 35, 36, and 40-48 of this application as set forth in the Non-Final Rejection, mailed on 25 November 2005. Accordingly, the application continues to be examined on the basis of its filling date or 01 February 2001.

Drawings

2. The drawings were received on 27 February 2006. These drawings are approved.

Response to Arguments

3. Applicant's arguments filed 27 February 2006 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, the O'Connor reference provides for the continuous recording and buffering of both television programs and promotions. In conjunction with recording a particular program interspersed with commercials, the system records/buffers portions of the program both before and after

commercials. Commercials, in view of O'Connor, are recorded at "predetermined points" in association with their particular position coinciding with the video program. No special definition or meaning appears to be invoked regarding the particular term "predetermined point". Therefore, the O'Connor reference teaches the limitation of "recording . . . [a] promotion at a predetermined point of the recording; buffering the portion of the television program after the predetermined point in a buffer; and recording the portion of the television program after the predetermined point from the buffer" in conjunction with continuing to record programs subsequent to those commercials.

The Zigmond et al. reference provides further evidence with respect to promotions being inserted into predetermined locations (ex. Figures 2A and 2B) and teaches the particular selection and insertion of advertising into live or recorded programming (Col 7, Lines 1-12; Col 14, Lines 1-12). Zigmond et al. contemplates that promotions may be recorded and that those recorded promotions may also be replaced (Col 14, Lines 6-9). However, the teachings of Zigmond relied upon relate to the desirability of selecting and inserting customized promotions, which taken in combination or used to modify the recording/buffering teachings of O'Connor are considered to meet the claimed limitation.

For example, as argued, the combination of O'Connor and Zigmond provide for the ability to record/buffer a television program wherein originally intended commercials are selected/replaced in association with the switching of the video feed and are subsequently recorded manner similar to other commercials and the remainder of the programming of O'Connor.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 2, 6-18, 35, 36, and 40-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor et al. (US Pub No. 2005/0244138 A1) in view of Zigmond et al. (US Pat No. 6,698,020).

In consideration of claim 1, Figure 10 of the O'Connor et al. reference discloses a "method for providing promotions with recorded programs". The method comprises "selecting a television program . . . to be recorded, wherein the television program is selected by a user" (Figures 11-13; Para. [0059] and [0068] – [0070]). The system subsequently, "records the selected television program. . . [and a] promotion at a predetermined point of the recording". In conjunction with performing the particular recording operation, the method involves "buffering the portion of the television program after the predetermined point in a

buffer; and recording the portion of the television program after the predetermined point from the buffer" (Figures 14-16; Para. [0025], [0034], [0049] – [0053], and [0071] - [0086]). Accordingly, the reference discloses the ability for a user to simultaneously watch and record a selected television program including promotions whereupon the user may subsequently playback recorded television programs alongside with altered commercials in a time-shifted manner.

The reference, however, does not particularly disclose "selecting . . . at least one promotion . . . , wherein . . . the promotion is selected by a processor". In an analogous art pertaining to video distribution systems and in particular targeted promotions associated with such, the Zigmond et al. reference discloses "method" for "selecting . . . at least one promotion . . . , wherein . . . the promotion is selected by a processor" associated with the client terminal in accordance with ad selection criteria [83] (Col 6, Lines 3-12; Col 7, Lines 13-61; Col 14, Lines 1-12). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify O'Connor et al. with the teachings of Zigmond et al. for the purpose of advantageously target, deliver, and present individually targeted advertisements to viewers (Zigmond et al.: Col 3, Line 45 – Col 4, Line 3). Taken in combination, the references provide a means such that a viewer may initially select a television program to watch/record wherein the system further selects at least one promotion to be watched/record based upon the advertising targeting criteria. Subsequently, upon the replay of the recorded television program and associated promotion, the user may potentially receive a different promotion on playback.

Claim 35 is rejected in light of the aforementioned combined teachings of O'Connor et al. and Zigmond et al.. In particular, Figure 10 illustrates of the O'Connor et al. reference illustrates a "system for providing promotions with recorded programs". The system comprises a "user input device configured to receive a user input to select a television program to be recorded" [1300] and a "processor" [1002]. The "processor" [1002] is "configured to . . . record the selected television program; record the . . . promotion at a predetermined point of the recording; buffer the portion of the television program after the predetermined point in a buffer; and record the portion of the television program after the predetermined point from the buffer" (Figures 14-16; Para. [0025], [0034], [0049] – [0053], and [0071] - [0086]). Accordingly, the reference discloses the ability for a user to simultaneously watch and record a selected television program including promotions whereupon the user may subsequently playback recorded television programs alongside with altered commercials in a time-shifted manner.

The reference, however, does not particularly that the processor further "selects . . . at least one promotion to be recorded". In an analogous art pertaining to video distribution systems and in particular targeted promotions associated with such, the Zigmond et al. reference discloses "system" whereby "a processor [is] configured to select at least one promotion" associated with the client terminal in accordance with ad selection criteria [83] (Col 6, Lines 3-12; Col 7, Lines 13-61; Col 14, Lines 1-12). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify O'Connor et al. with the teachings of Zigmond et al. for the purpose of advantageously target, deliver, and present individually targeted advertisements to viewers

(Zigmond et al.: Col 3, Line 45 – Col 4, Line 3). Taken in combination, the references provide a means such that a viewer may initially select a television program to watch/record wherein the system further selects at least one promotion to be watched/record based upon the advertising targeting criteria. Subsequently, upon the replay of the recorded television program and associated promotion, the user may potentially receive a different promotion on playback.

Claims 2 and 36 are rejected wherein the "promotion is selected based upon the content of the program" (Zigmond et al.: Col 12, Line 60 – Col 13, Line 6).

Claim 6 is rejected wherein the method further comprises "recording both the program and the promotion on a storage unit" such as the HDD [1018] of O'Connor et al.

In consideration of claims 7, 9-11, 40, and 42-44, the Zigmond et al. reference discloses that "promotions" may be displayed either so as to replace existing advertisement slots or may be placed at any point in the programming. Accordingly, during the recording of such a program a promotion would be "recorded" at the "beginning of the program", the "end of the program", the "beginning and the end of the program", or "at any desired point within the program" (Zigmond et al.: Col 14, Lines 1-12; Col 16, Lines 20-43). Similarly, the playback of the aforementioned recorded media may have commercials "integrated" at different points in time.

Claims 8 and 41 are rejected wherein the O'Connor et al. reference is operable to "record a flag . . . to indicate the beginning of the program during playback" so as to locate the beginning of a particular program within the storage medium (Figures 3 and 4; Para. [0032] and [0036]).

Claims 12, 13, 16-18, 45, and 48 are rejected wherein the method further comprises "receiving the program and the promotion" and "program guide data" and subsequently "storing" them on a "storage unit" comprising a "plurality of storage units" (Zigmond et al.: Figure 5; Col 12, Line 60 – Col 13, Line 6; Col 14, Lines 1-12; Col 15, Lines 24-34).

Claims 14, 15, 46, and 47 are rejected wherein the "program, the promotion, and the program guide data are received" either via a "single broadcast channel" or via a "plurality of broadcast channels" (Zigmond et al. Col 7, Lines 1-25; Col 14, Line 66 – Col 15, Line 16).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Flickinger (US Pub No. 2005/0283796 A1) reference discloses a system and method for delivering addressable or targeted advertisements which are inserted into programming as it is recorded.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory

period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott Beliveau
Examiner
Art Unit 2614

SEB
March 8, 2006